



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,919	08/06/2003	Claudius Zeiler	5858-00800	8849

7590  
Conley Rose, P.C.  
P.O. Box 684908  
Austin, TX 78768-4908

01/17/2007

EXAMINER

REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
----------	--------------

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/635,919

Applicant(s)

ZEILER ET AL.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 21, 2006 has been entered.

### ***Specification***

The disclosure is objected to because of the following informalities: The disclosure does not appear to clarify what is meant by "a pair of parallel-spaced shaft edge surfaces adjoining lateral extents of the first and second shaft sides" as stated in claim 15. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Herzberg (U.S. Patent No. 4,988,350), previously cited by examiner on 892, paper number 20050613.

Herzberg discloses an implant plate comprising a head-end portion, 25a, and a shaft-end portion, 24, wherein the head-end portion comprises a first head side facing and adapted to bear against the bone, a second head side opposite the first head side, and a pair of parallel-spaced head edge surfaces adjoining lateral extents of the first and second head sides (see figures 17 and 18) wherein the shaft-end portion comprises a first shaft side facing and adapted to bear against the bone, a second shaft side opposite the first shaft side, and a pair of parallel-spaced shaft edge surfaces adjoining lateral extents of the first and second shaft sides (see figures 17 and 18) holes for bone screws, e.g. 26, and at least one raised receiving member, e.g. 126, 126', 126" extending perpendicularly outward from only the second head side, wherein the receiving member has an aperture, e.g. 129, of circular enclosed inner diameter that surrounding a central axis extending substantially parallel to the lateral extents of the first and second head sides, wherein each receiving member has a blunt/rounded edged aperture, 129, (see figures 17 and 18). A hole produced by a laser device or by punching disclosed in line 21 of claim 15 is a product-by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of it production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

With regard to the statement of intended use and other functional statements they do not impose any structural limitations on the claims distinguishable over Herzberg, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sioufi (US Patent Number 5,409,489).

Sioufi discloses comprising a head-end portion, 77, and a shaft-end portion, wherein the head-end portion comprises a first head side facing and adapted to bear against the bone, a second head side opposite the first head side, and a pair of parallel-spaced head edge surfaces adjoining lateral extents of the first and second head sides (see figures 8a and 8b) wherein the shaft-end portion comprises a first shaft side facing

Art Unit: 3733

and adapted to bear against the bone, a second shaft side opposite the first shaft side, and a pair of parallel-spaced shaft edge surfaces adjoining lateral extents of the first and second shaft sides (see figures 8a and 8b), holes for bone screws, 85, a raised receiving member, 88, (see figures 8a and 8b), wherein the receiving member has an aperture of circular enclosed inner diameter that surrounding a central axis extending substantially parallel to the lateral extents of the first and second head sides (see figure 8b below), and wherein the receiving member is provided with the aperture by being formed to be an eyelet perpendicular to an outer edge of the head-end portion and having a drill hole (see figures 8a and 8b). Furthermore, an outer edge of the aperture in the receiving member is blunted, rounded, and smoothed on entry and exit side, and all edges and rims intended to contact the flexible fastening member and human tissue are blunted, rounded, and smoothed (see figures 8a and 8b). A hole produced by a laser device or by punching disclosed in line 21 of claim 15 is a product-by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

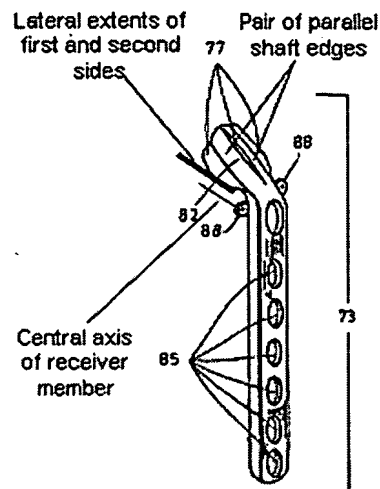


FIG. 8b

Sioufi discloses the claimed invention except the receiving member extending perpendicularly outward from only the second head side. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sioufi with the receiving member extending perpendicularly outward from only the second head side, since it has been held that mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. In addition, it would be obvious to relocate the receiving member to the second head side to provide easier access by the surgeon to the receiving members.

Furthermore, it would have been an obvious matter of design choice to construct the device of Sioufi with the receiving member extending perpendicularly outward from only the second head side, since applicant has not disclosed that receiving member extending perpendicularly outward from only the second head side solves any stated problem or is for any particular purpose and it appears that the invention would perform

Art Unit: 3733

equally well with the receiving member extending perpendicularly outward from only the first head side.

With regard to the statement of intended use and other functional statements they do not impose any structural limitations on the claims distinguishable over Sioufi, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

Applicant's arguments filed on November 21, 2005 have been fully considered but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Sioufi reference. As stated above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sioufi with the receiving member extending perpendicularly outward from only the second head side, since it has been held that mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. In addition, it would be obvious to relocate the receiving member to the second head side to provide easier access by the surgeon to the receiving members. Furthermore, it would have been an obvious matter of design choice to construct the device of Sioufi with the receiving member extending perpendicularly outward from only the second head side, since applicant has not disclosed that receiving member extending perpendicularly outward from only the



Art Unit: 3733

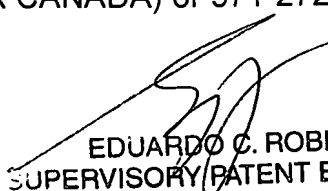
second head side solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the receiving member extending perpendicularly outward from only the first head side. Moreover, Sioufi teaches a receiving member having an aperture of circular enclosed inner diameter that surrounding a central axis extending substantially parallel to the lateral extents of the first and second head sides (see figure 8b above).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER